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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,509	12/07/2000	Thomas Schaeck	DE919990082	1249

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EXAMINER

COLIN, CARL G

ART UNIT	PAPER NUMBER
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2136

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,509

Applicant(s)

SCHAECK ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

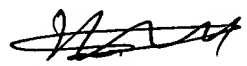
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 5/11/2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Response to Arguments

2. In response to communications filed on 5/11/2006, the following claims 16-47 are presented for examination.

2.1 Applicant's remarks in the brief, filed on 5/11/2006, with respect to the rejection of claims 16-47 have been fully considered but they are moot in view of the new ground(s) of

rejection. Upon further consideration, a new ground of rejection of claims 16-47 is set forth below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-30 and 32-47 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,446,266 to **Beuk et al.**

As per claim 16, **Beuk et al** discloses a method for controlling card holder verification comprising: checking the presence of a trusted association between at least one device and a card usable with the at least one device, for example (see column 2, lines 55-65 and column 3, lines 10-16) and wherein if the checking indicates the presence of the trusted association then suppressing involvement of holder of the card in performing card holder verification, (see column 3, lines 11-16); otherwise, if the checking indicates no trusted association then involving the holder of the card in performing card holder verification (see column 3, lines 21-31).

As per claim 17, **Beuk et al** discloses the claimed method of claim 16, wherein the at least one device is located in a trusted environment (see column 4, lines 1-11).

As per claim 18, **Beuk et al** discloses the claimed method of claim 16, wherein the card comprises a chipcard (see column 1, lines 52-55).

As per claim 19, **Beuk et al** discloses the claimed method of claim 16, wherein the suppressing involvement comprises performing card holder verification hidden from the holder of the card (see column 3, lines 11-16).

As per claim 20, **Beuk et al** discloses the claimed method of claim 19, wherein the performing card holder verification hidden from the holder of the card comprises automatically obtaining a personal identification number of the holder of the card and verifying the personal identification number without intervention of the holder of the card (see column 3, lines 11-16).

As per claim 21, **Beuk et al** discloses the claimed method of claim 16, wherein the suppressing involvement comprises refraining from performing card holder verification (see column 3, lines 11-16).

As per claim 22, **Beuk et al** discloses the claimed method of claim 16, wherein the checking the presence of a trusted association between a device of the at least one device and the card comprises comparing a card identifier stored on the card with one or more card identifiers stored in the device (see column 2, lines 55-65 and column 3, lines 10-16).

As per claim 23, **Beuk et al** discloses the claimed method of claim 22, wherein the card identifier is associated with a personal identification number usable in card holder verification, and said method further comprises replacing the personal identification number with another personal identification number (see column 1, lines 36-40).

As per claim 24, **Beuk et al** discloses the claimed method of claim 22, wherein the card identifier is associated with a personal identification number usable in card holder verification, and said method further comprising erasing the association between the card identifier and the personal identification number (see column 1, lines 36-41).

As per claim 25, **Beuk et al** discloses the claimed method of claim 16, wherein the checking the presence of a trusted association between a device of the at least one device and the card comprises comparing an identifier of the device with one or more device identifiers stored on the card (see column 2, lines 55-65 and column 3, lines 10-16).

As per claim 26, **Beuk et al** discloses the claimed method of claim 25, wherein the device identifier is associated with a personal identification number usable in card holder verification, and said method further comprises replacing the personal identification number with another personal identification number (see column 1, lines 36-40).

As per claim 27, **Beuk et al** discloses the claimed method of claim 25, wherein the device identifier is associated with a personal identification number usable in card holder verification,

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and said method further comprising erasing the association between the card identifier and the personal identification number (see column 1, lines 36-41).

As per claim 28, **Beuk et al** discloses the claimed method of claim 16, wherein the suppressing involvement comprises automatically obtaining a personal identification number of the holder of the card and verifying the personal identification number without requesting information from the holder of the card and wherein the involving the holder of the card comprises requesting the holder of the card to enter the personal identification number (see column 3, lines 12-31).

As per claim 29, **Beuk et al** discloses the claimed method of claim 16, further comprising associating the at least one device and the card (see column 1, lines 53-63).

As per claim 30, **Beuk et al** discloses the claimed method of claim 29, further comprising controlling the association between a device of the at least one device and the card (see column 4, lines 17-22).

As per claim 32, **Beuk et al** discloses the claimed method of claim 16, wherein the checking is between at least one device and a plurality of cards and where in the suppressing is for a plurality of holders (see column 3, lines 38-39, lines 64-68; and column 4, lines 1-17).

As per claim 33, **Beuk et al** discloses a method for performing card holder verification said method comprising: checking the presence of a trusted association between at least one device and a card usable with the at least one device, for example (see column 2, lines 55-65 and column 3, lines 10-16) and performing card holder verification based on the checking wherein if the checking indicates the presence of the trusted association then a personal identification number of the holder of the card is automatically obtained and without requesting information from the holder of the card (see column 3, lines 11-16); however, if the checking indicates no trusted association then the holder of the card is requested to enter the personal identification number to verify the holder of the card (see column 3, lines 21-31).

As per claim 34, **Beuk et al** discloses a system of controlling card holder verification, said system comprising means for checking the presence of a trusted association between at least one device and a card usable with the at least one device, for example (see column 2, lines 55-65 and column 3, lines 10-16) and means for suppressing involvement of holder of the card in performing card holder verification, if the checking indicates the presence of a trusted association (see column 3, lines 11-16); or for involving the holder of the card in performing card holder verification if the checking indicates no trusted association (see column 3, lines 21-31).

As per claim 35, **Beuk et al** discloses the claimed system of claim 34, wherein the means for suppressing involvement comprises means for performing card holder verification hidden from the holder of the card (see column 3, lines 11-16).

As per claim 36, **Beuk et al** discloses the claimed system of claim 35, wherein the means for performing card holder verification hidden from the holder of the card comprises means for automatically obtaining a personal identification number of the holder of the card and verifying the personal identification number without intervention of the holder of the card (see column 3, lines 11-16).

As per claim 37, **Beuk et al** discloses the claimed system of claim 34, wherein the means for suppressing involvement comprises refraining from performing card holder verification (see column 3, lines 11-16).

As per claim 38, **Beuk et al** discloses the claimed system of claim 34, wherein the means for checking the presence of a trusted association between a device of the at least one device and the card comprises means for comparing a card identifier stored on the card with one or more card identifiers stored in the device (see column 2, lines 55-65 and column 3, lines 10-16).

As per claim 39, **Beuk et al** discloses the claimed system of claim 34, wherein the means for checking the presence of a trusted association between a device of the at least one device and the card comprises comparing an identifier of the device with one or more device identifiers stored on the card (see column 2, lines 55-65 and column 3, lines 10-16).

As per claim 40, **Beuk et al** discloses a system of performing card holder verification, said system comprising at least one processor to perform card holder verification based on whether a trusted association exists between at least one device and a card usable with the at least one device, wherein (figure 1) (see column 2, lines 55-65 and column 3, lines 10-16): if a checking of the trusted association indicates the presence of the trusted association, then a personal identification number of the holder of the card is automatically obtained and verified without requesting information from the holder of the card (see column 3, lines 11-16); however, if the checking indicates no trusted association, then the holder of the card is requested to enter the personal identification number to verify the holder of the card (see column 3, lines 21-31).

As per claim 41, **Beuk et al** discloses an article of manufacture comprising at least one computer usable medium having computer readable program code logic to control card holder verification, the computer readable program code logic comprising: check logic to check the presence of a trusted association between at least one device and a card usable with the at least one device; (see column 2, lines 55-65 and column 3, lines 10-16) and logic to suppress involvement of a holder of the card in performing card holder verification, if the checking indicates the presence of the trusted association, (see column 3, lines 11-16); or to involve the holder of the card in performing card holder verification, if the checking indicates no trusted association (see column 3, lines 21-31).

As per claim 42, **Beuk et al** discloses the claimed article of manufacture of claim 41 wherein the suppress logic to suppress involvement comprises perform logic to perform card holder verification hidden from the holder of the card (see column 3, lines 11-16).

As per claim 43, **Beuk et al** discloses the claimed article of manufacture of claim 42, wherein the perform logic comprises obtain logic to automatically obtain a personal identification number of the holder of the card and verify logic to verify the personal identification number without intervention of the holder of the card (see column 3, lines 11-16).

As per claim 44, **Beuk et al** discloses the claimed article of manufacture of claim 41, wherein the suppress logic to suppress involvement comprises refrain logic to refrain from performing card holder verification (see column 3, lines 11-16).

As per claim 45, **Beuk et al** discloses the claimed article of manufacture of claim 41, wherein the check logic to check the presence of a trusted association between a device of the at least one device and the card comprises compare logic to compare a card identifier stored on the card with one or more card identifiers stored in the device (see column 2, lines 55-65 and column 3, lines 10-16).

As per claim 46, **Beuk et al** discloses the claimed article of manufacture of claim 41, wherein the check logic to check the presence of a trusted association between a device of the at least one device and the card comprises compare logic to compare an identifier of the device

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with one or more device identifiers stored on the card (see column 2, lines 55-65 and column 3, lines 10-16).

As per claim 47, **Beuk et al** discloses an article of manufacture comprising at least one computer usable medium having computer readable program code logic to perform card holder verification, the computer readable program code logic comprising: check logic to check the presence of a trusted association between at least one device and a card usable with the at least one device (see column 2, lines 55-65 and column 3, lines 10-16), and perform logic to perform card holder verification based on the checking, wherein if the checking indicates the presence of the trusted association, then a personal identification number of the holder of the card is automatically obtained and verified without requesting information from the holder of the card (see column 3, lines 11-16); however, if the checking indicates no trusted association, then the holder of the card is requested to enter the personal identification number to verify the holder of the card (see column 3, lines 21-31).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

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which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,446,266 to **Beuk et al** in view of US Patent 6,179,205 to **Sloan**.

As per claim 31, **Beuk et al** substantially discloses the claimed method of claim 30. **Beuk et al** does not explicitly disclose using a network to control the association between the device and the card. Performing the control remotely is an obvious modification and a design choice that only requires routine skill in the art as it allows to perform an operation over a long distance. **Sloan** in an analogous art discloses automatic locking and unlocking application in a smart card without the need of a PIN and further discloses the issuer of the card can generate or regenerate password of a smart card if a smart card device is unable to do so by having it downloaded into the card holder's personal computer system (see column 5, lines 1-10 and column 8, line 65 through column 9, line 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Beuk et al** to allow the control of the association between the device and the card to be done over a network because the advantage is that control may be performed remotely without physical contact with the device and it allows another device located at a different location to change the security code in case the device being present is not capable of doing so as taught by **Sloan** (see column 5, lines 1-10 and column 8, line 65 through column 9, line 7). This modification would have been obvious because one of ordinary skill in the art would have recognized the advantage of allowing

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an authorized user to change the security code wherever that authorized user is being located as suggested by **Sloan**.

Conclusion


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

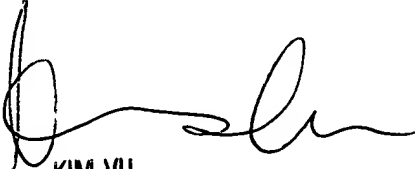
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cc

Carl Colin
Patent Examiner
July 19, 2006


KAMBIZ ZAND
PRIMARY EXAMINER


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